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| EXAMINER | | | | |
| MEYER, JACOB B | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/551,361

Applicant(s)

SYKES, JOHN

Examiner

JACOB MEYER

Art Unit

3618

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) 12, 13 and 17-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 and 14-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 September 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 09/28/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Species 1, claims 1-11 and 14-16 in the reply filed on 12/18/2008 is acknowledged. Claims 12-13 and 17-20 withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim at this time.

Priority

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

3. The information disclosure statement (IDS) submitted on 09/28/2005 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

Claim Objections

4. Claims 8 and 9 are objected to because of the following informalities: In line 2 of claim 8, and line 1 of claim 9, delete "elongate members" and insert --elongated members--.

Appropriate correction is required.

5. Claim 11 is objected to because of the following informalities: In line 2 of the claim, delete "allow the said additional" and insert either --allow the additional-- or --allow said additional--. Appropriate correction is required.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-11 and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "and/or" found in claims 1, 3, and 10 renders the claims indefinite because it is an alternate expression and it is subject to more than one interpretation. Claims 2-11 and 14-16 are rejected as being dependent upon a base claim rejected under 35 U.S.C. 112.

8. Claim 6 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 recites the limitation "the bindings" in line 2 of the claim. There is insufficient antecedent basis for this limitation in the claim.

9. Claim 16 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. A claim cannot depend from itself. In line 1 of claim 16, delete "according to claim 16" and insert a proper dependency.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 6, 8, and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Sargent (US Pat. No. 5,106,112).

Regarding claim 1, Sargent teaches an assembly for the carriage of skis across a surface (Abstract), said assembly including a reception means (Element 42 or 58 as disclosed in separate embodiments) for the reception of an end of the skis, and gripping means (Element 24) wherein said reception means are connected to at least one wheel (Element 52), roller and/or skid for contact with the surface to allow the skis to be pulled or pushed by a person along the surface and said gripping means are attached to the skis at a location remote from the reception means (Figures 1 and 6, column 2, lines 24-54 and column 4, line 41-54).

Regarding claim 6, Sargent teaches an assembly according to claim 1 wherein the gripping means are attached to the reception means (by means of Elements 16 and 18 seen in Figure 6).

Regarding claim 8, Sargent teaches an assembly according to claim 6 wherein the gripping means are attached to the reception means via elongate members (Element 16).

Regarding claim 10, Sargent teaches an assembly according to claim 1 wherein the reception means include location means which allow interconnection with other similar

assemblies to allow a plurality of pairs of skis and/or ski poles to be received on a common assembly (Figures 5 and 8, column 3, lines 48-58).

Regarding claim 11, Sargent teaches an assembly according to claim 1 wherein additional components (Element 70), skis or boards can be attached to a set of skis (by means of the support device, Element 10) supported by the assembly of the invention to allow the said additional components, skis or boards to be moved via the assembly (Figure 6).

12. Claims 1-4 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Osmond (US Pat. No. 3,504,921).

Regarding claim 1, Osmond teaches an assembly for the carriage of skis across a surface (Abstract), said assembly including a reception means (lower end of Element 12, lower Element 16 and Element 47) for the reception of an end of the skis, and gripping means (Element 31) wherein said reception means are connected to at least one wheel (Elements 39 and 41, by means of Element 12 and other members), roller and/or skid for contact with the surface to allow the skis to be pulled or pushed by a person along the surface and said gripping means are attached to the skis at a location remote from the reception means (Figure 1).

Regarding claim 2, Osmond teaches an assembly according to claim 1 wherein the wheels or rollers can be used instead of or be replaced by or used in conjunction with a skid or skids (Element 32) located on the assembly (Figure 5).

Regarding claim 3, Osmond teaches an assembly according to claim 2 wherein the skids and/or rollers and wheels are selectively movable between in-use and storage positions (Figure 6, column 4, lines 66-72).

Regarding claim 4, Osmond teaches an assembly according to claim 1 wherein the reception means includes a part (Element 59) which is movable between in-use and storage conditions (column 6, lines 46-68).

Regarding claim 7, Osmond teaches an assembly according to claim 1 wherein the gripping means are locatable with the bindings provided on at least one of the skis (Figure 1).

13. Claims 1, 4, 6, 8-9, and 14-16 are rejected under 35 U.S.C. 102(b) as being anticipated by Stark et al (US Pat. No. 6,086,102).

Regarding claim 1, Stark et al (hereinafter as Stark) teaches an assembly for the carriage of skis across a surface (Abstract), said assembly including a reception means (Element 10) for the reception of an end of the skis, and gripping means (Elements 20, 23, and 24) wherein said reception means are connected to at least one wheel, roller (Element 11) and/or skid for contact with the surface to allow the skis to be pulled or pushed by a person along the surface and said gripping means are attached to the skis at a location remote from the reception means (Figure 1).

Regarding claim 4, Stark teaches an assembly according to claim 1 wherein the reception means includes a part which is movable between in-use and storage conditions (wherein when in the storage condition, the reception means is located in Element 22 and outside and away from Element 22 when in the in-use condition as shown in Figure 1).

Regarding claim 6, Stark teaches an assembly according to claim 1 wherein the gripping means are attached to the reception means (by means of Elements 18, 19 seen in Figure 1).

Regarding claim 8, Stark teaches an assembly according to claim 6 wherein the gripping means are attached to the reception means via elongate members (Element 18).

Regarding claim 9, Stark teaches an assembly according to claim 8 wherein the elongate members are elasticated cords (column 3, lines 36-42).

Regarding claim 14, Stark teaches an assembly according to claim 1 wherein the skis are pulled or pushed via the assembly by a person gripping the gripping means at a portion of the skis positioned remotely from the reception means (Figure 1, column 4, lines 14-53).

Regarding claim 15, Stark teaches an assembly according to claim 1 wherein the gripping means include one or a number of straps which pass around the skis to keep the same together in a face to face relationship (Figure 1, column 4, lines 14-53).

Regarding claim 16, Stark teaches the invention wherein the gripping means include a handle (Element 24) or gripping portion which allows the user to grip the same to push or pull the skis via the assembly (Figure 1, column 4, lines 14-53).

Claim Rejections - 35 USC § 103

14. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

15. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
16. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stark et al (US Pat. No. 6,086,102).

Regarding claim 5, Stark teaches the invention except for specifically wherein the gripping means of the assembly are received in the reception means for storage and removable from the reception means to be attached to a remote location on the skis in an in-use condition. It would have been obvious to one having ordinary skill in the art at the time the invention was made to store the gripping means (At least Element 20 of the gripping means) within Element 15 of the reception means when in the storage condition and therefore removable from the reception means to be attached to a remote location (as shown in Figure 1) on the skis in an in-use condition, since it would be a space-efficient means of accommodating all elements in the storage condition. Moreover, "When there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product is not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show it was obvious under 35 U.S.C. 103." KSR Int'l Co. v. Teleflex Inc., 127 S.Ct. 1727, 1742, 82 USPQ2d 1385, 1396 (2007). Therefore, it would have been obvious to try placing the elements in the claimed configuration in order to save space.

Conclusion

17. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The documents cited in the Notice of References Cited attached hereto contain subject matter that may be of interest to Applicant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACOB MEYER whose telephone number is (571)270-3535. The examiner can normally be reached on Monday - Thursday 9am to 7pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, CHRISTOPHER ELLIS can be reached on 571-272-6914. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. M./
Examiner, Art Unit 3618
01/13/2009

/Christopher P Ellis/
Supervisory Patent Examiner, Art Unit
3618

